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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, KIM T

ART UNIT

PAPER NUMBER

3713

07

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/027,808

Applicant(s)

CANNON ET AL.

CS

Examiner

Kim Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 13 and 16 are objected to because of the following informalities:

In claim 13, line 2, and claim 16, line 2, the claimed limitation “a player” should be corrected to “the player” to provide proper antecedent basis.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - a) In claim 1, lines 4-7, the claimed limitation “each selection space having ... to enable a single game entry” is ambiguous. It is not clear which element is positioned in the same location with respect to the game spaces. Is it the “each selection space” in line 4, or is it the “gaming space” in line 5, that is positioned in the same location with respect to each of the gaming spaces? Further, the claimed limitation does not appear to be logical, because how can the selection space

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be in the same location with a gaming space, because a selection space should be inside the gaming space.

Further, the term "substantially" in claim 1, lines 4-5, is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

- b) In claims 5-7, the claimed limitations in claims 5-7 do not further limit the game form, because the game form itself does not contain an input element, especially the game form can not contain a touch sensitive video display screen.
- c) Claims 8, 12, 15, and 18, are similarly rejected as discussed in claims 1, and 5-7 above.
- d) Claims 2-4, 9-11, 13-14, 16-17, and 19-20, are rejected as being dependent on the rejected base claim.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (e) the invention was described in-
  - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

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(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1, 8, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Nulph (US. Patent No. 6,234,899).

As per claim 1, 8, and 18, Nulph discloses a multiple entry game form comprising a plurality of game spaces (play A and play B in Fig. 3A) with selection spaces 1-80 (Fig. 3A) arranged in the same locations with the corresponding selection spaces in other game spaces; and a gaming space indicator (player A, play B in Fig. 3A).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-3, 9-10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nulph (US. Patent No. 6,234,899).

a. As per claim 2-3 and 9-10, Nulph discloses that the form is in computer readable format (col. 3, lines 35-36). Further, printing indicia on a substrate would have been well known to a person of ordinary skill in the art at the time the invention was made. It would have been obvious

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to a person of ordinary skill in the art at the time the invention was made to print the indicia on a substrate, since selecting a specific material for a game form requires only routine skill in the art.

b. As per claim 17, displaying game statistics of a player would have been well known to a person of ordinary skill in the art at the time the invention was made.

7. Claims 4-7, 11-16, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nulph (US. Patent No. 6,234,899) in view of McNabola (US. Patent No. 6,368,213).

a. As per claim 4-7, 11, and 19, McNabola discloses displaying the image of the game form on a video display and providing a player input element which is a touch screen or an element for indexing a cursor (col. 2, lines 11-17). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to display the game form and to provide the player input element of McNabola to the game of Nulph in order to allow the player to input the game form using a video game machine.

b. As per claim 12, 15, and 20, McNabola discloses presenting random outcome by altering the displayed game space indicator (col. 5, lines 11-16).

c. As per claim 13-14 and 16, refer to discussion in claim 17 above.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (703) 308-7915. The examiner can


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normally be reached on Monday-Thursday from 7:30AM to 5:30PM ET. The fax phone number for this Group is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

kn

Date: July 9, 2003

  
**KIM NGUYEN**  
**PRIMARY EXAMINER**